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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,200	05/15/2001	Gerassimos M. Makrigiorgos	700157-48900 C	9467
7590		03/24/2004	EXAMINER	
Ronald I. Eisenstein		SWITZER, JULIET CAROLINE		
NIXON PEABODY LLP		ART UNIT		
101 Federal Street		PAPER NUMBER		
Boston, MA 02110		1634		

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8M

Advisory Action

Application No.

09/858,200

Applicant(s)

MAKRIGIORGOS, GERASSIMOS
M.

Examiner

Juliet C. Switzer

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 2/12/04. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): provisional double patenting.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 12 and 13.

Claim(s) objected to: _____

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: 14 and 15.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

JEFFREY FREDMAN
PRIMARY EXAMINER

Continuation of 2. NOTE: The amendments to the claims raise new issues that would require further search and consideration, as was noted in the final rejection (see page 8 of the final rejection) .

Continuation of 5. does NOT place the application in condition for allowance because: The arguments are addressed insofar as they pertain to the pending claims, noting that the amendment filed after final will not be entered.

Applicant again points out that Modrich begins with a single known gene rather than a population of multiple genes (p. 6 of response). As the amendment was not entered, it is noted that this limitation which applicant argues is not present in the pending claims. Thus the arguments set forth in the final rejection by the examiner remain relevant to this point.

Applicant points out that Wodicka does not teach detection of mutations, unlike the present invention. However, as noted in the rejection of record, while Wodicka does not explicitly demonstrate the detection of mutations, Wodicka et al. do specifically teach that their array can be used in the detection of mutations (the "genetic differences" discussed by Wodicka et al.). Given that Modrich et al. teaches the use of any suitable method for the identification of the fragments, and the teaching of Wodicka et al. that their array can be used for additional analytical methodologies, the examiner maintains the rejections of record.

It is noted that the terminal disclaimer filed with the after-final response has been approved, and as such, pending claims 12 and 13 are now allowed.